

REMARKS

Claims 1-34 were previously pending. Claims 20-25 have been canceled. Claim 2 has been rewritten in independent form, including the limitations of claim 1 from which it depended. Thus, claim 2 has the same scope as before and no additional searching is needed for reconsideration of claim 2. Reconsideration of presently pending claims 1-19 and 26-34 is respectfully requested in light of the above amendments and the following remarks.

Double Patenting and Restriction Requirement

Claims 1-20 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 101-103, 106-110, 112-113 of copending Patent Application No. 09/924,298. Applicants again acknowledge this provisional rejection and will address any double patenting issues if and when a double patenting problem comes to fruition.

As previously noted by Applicants, the double patenting provisional rejection is at odds with the restriction requirement. On the one hand, the Examiner identifies two distinct inventions—a body member (claims 1-20 and 26-34) and an implantable endoprosthesis (claims 21-25)—which forms the basis for the Examiner's restriction requirement. On the other hand, the Examiner compares the body member claims (1-20 and 26-34) to the implant claims of U.S. Ser. No. 09/924,298 and argues that the claims are "not patentably distinct from each other."

This situation is directly analogous to using a parent application as the basis for a double patenting rejection of a divisional application, which is expressly prohibited by MPEP § 804.01 and 35 U.S.C. § 121.

§ 102 Rejections

French Patent No. 2,805,985 to Viart et al.

Claims 1, 2, 8, 9, 17-19, and 26-34 were rejected under 35 U.S.C. § 102(e) as being anticipated by French Patent No. 2,805,985 to Viart et al. ("Viart"). In making this response Applicants have considered U.S. Patent No. 6,682,562 to Viart et al. as the English equivalent of the '985 French patent.

The PTO provides in MPEP § 2131 that

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, to sustain the rejection of these claims Viart must teach all of the claimed elements. However, Viart fails to disclose all of the claimed elements of independent claims 1, 2, 26, and 34 and, therefore, dependent claims 8, 9, and 17-19.

With respect to amended claim 1, Viart at least fails to teach "wherein the body member is adapted to articulate with the shell such that one or more surfaces of the shell come into contact with the first component, but not the second component." Rather, in Viart both the central core (4) and annular element (5) articulate with the upper and lower plates (2, 3), as best seen in Fig. 2. Thus, for at least this reason Viart fails to anticipate independent claim 1 and its dependent claims 2, 8, 9, and 17-19.

Further, with respect to independent claim 2 Viart at least fails to teach "wherein the second component [formed from a resilient second material] is a central component disposed between the first component and a third component also formed from the [wear resistant] first material." Rather, Viart teaches "[t]he central core 4 is made of a plastic with good slip characteristics, such as polyethylene" and "[t]he annular element 5 is made of viscoelastic material such as biocompatible elastomer for example." Assuming, *arguendo*, that the plastic of the central core is a wear resistant material, the wear resistant material is positioned in the middle of the annular element formed of the viscoelastic material. Thus, the viscoelastic material is positioned outside and around the wear resistant material, not between two wear resistant

components as required by claim 2. Therefore, for at least this reason Viart fails to anticipate independent claim 2.

Independent claim 26 contains limitations similar to those of both claims 1 and 2 addressed above. Claim 26 recites, in part, “a third portion positioned at least partially between the first and second portions to avoid contact with the shell structure, the third portion formed from a resilient material.” Thus, for at least these same reasons Viart fails to anticipate independent claim 26 and its dependent claims 27-33.

With respect to independent claim 34, Viart at least fails to teach “a first portion configured to articulate with the first half of the shell structure, the first portion formed from a first wear-resistant material and having at least one recess; a second portion configured to articulate with the second half of the shell structure, the second portion formed from the first wear-resistant material and having at least one projection adapted to slidably engage with the at least one recess of the first portion.” More specifically, Viart simply fails to disclose “a first portion ... having at least one recess” and “a second portion ... having at least one projection adapted to slidably engage with the at least one recess of the first portion.” The Examiner has not explained how Viart could possibly teach these limitations. Thus, for at least this reason Viart fails to anticipate independent claim 34.

Therefore, the §102 rejections of claims 1, 2, 8, 9, 17, 18, 19, and 26-34 are not supported by Viart. Thus, Applicants respectfully request Examiner withdraw these §102(e) rejections.

§103 Rejections

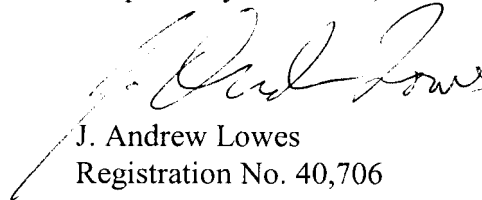
Claims 3-7 and 10-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Viart. However, as shown above Viart fails to teach all of the elements of independent claim 1 from which claims 3-7 and 10-16 depend and further limit. Thus, the §103 rejection of claims 3-7 and 10-16 over Viart cannot be supported.

CONCLUSION

It is clear from the foregoing that independent claims 1, 2, 26, and 34 are in condition for allowance. Dependent claims 3-19 and 27-33 depend from and further limit the independent claims and, therefore, are allowable as well.

It is believed that all matters set forth in the Final Office Action have been addressed, and that claims 1-19 and 26-34 are in condition for allowance. Favorable consideration and an early indication of the allowance of the claims are respectfully requested. Should the Examiner deem that an interview with Applicant's undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

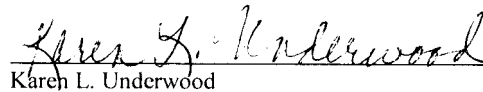
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